

## **REMARKS**

### **Claim Rejections -- 35 USC § 103**

Claims 25-26 and 28-30 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,824,43 to Kawakami ("Kawakami") in view of U.S. Patent No. 4,297,249 to Przybyla ("Przybyla"), claim 31 has been rejected under 35 USC 103(a) as being unpatentable over Kawakami in view of Przybyla and further in view of US Patent No. 4,086,392 to Mao ("Mao"), claims 32-35 are rejected under 35 USC 103(a) as being unpatentable over Kawakami in view of Przybyla, and further in view of U.S. Patent No. 4,146,685 to Tucholski ("Tucholski") and claims 36-40 have been rejected as being unpatentable over Kawakami in view of Przybyla, and further in view of Mao and U.S. Patent No. 5,688,616 to Yamawaki ("Yamawaki"). Applicant traverses these rejections because the examiner has not established a *prima facie* case of obviousness for the reasons set forth below and the rejections are improper and shown be withdrawn.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. *See MPEP. § 2143*. In the present case, the examiner has not shown that the prior art teaches or suggests all of the claim limitations and therefore the rejection is improper and should be withdrawn.

#### **Claim 25**

The examiner has rejected claim 25 as being obvious over Kawakami in view of Przybyla. *See Final Office Action at 2-3*.

In the rejection of this claim, the examiner asserts that Kawakami teaches "the process of making an anode electrode by adding a precipitated zinc hydroxide with a salt of an acid such as sodium phosphate" and cites to Col. 18, lines 1-25 of Kawakami. *Id.* However, Kawakami does not teach or suggest this claim element. Kawakami provides "The negative pole activating material

for the alkali-zinc battery may be zinc, zinc alloy, zinc oxide or zinc hydroxide, the negative pole activating material being uniformly kneaded with a bonding material or a kneading solution to obtain paste.” See *Kawakami* at Col. 18, lines 10-15. Nothing in this portion of *Kawakami* nor in any portion of *Kawakami* teaches or suggests “preparing a first precipitate of zinc hydroxide and **mixing a solution of an alkali salt of either a C<sub>6</sub>-C<sub>30</sub> fatty acid or a C<sub>6</sub>-C<sub>30</sub> alkyl sulfonic acid with a suspension of the first precipitate**” (emphasis added) as set forth in claim 25.

Furthermore, nothing in *Przybyla* teaches or suggests the steps of the method set forth in claim 25. In summary, the examiner has not established a prima facie case of obviousness for claim 25 because the examiner has not shown that the combination of prior art relied on by the examiner (*Kawakami* and *Przybyla*) teaches or suggests all of the claim limitations. Therefore, pursuant to MPEP 2143, the examiner has not established a prima facie case of obviousness and the rejection must be withdrawn.

#### Claims 26 and 28-40

The claims depend from claim 25 and the obviousness rejection for these claims is similarly defective since the examiner relies on *Yamakami* as the primary reference for the rejections of these claims and therefore the examiner has not established the prima facie case of obviousness for these claims for at least the same reasons as claim 25 set forth above.

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### **Conclusion**

Based on the above, Claims 25 -26, and 28-40 are now in condition for allowance. Please feel free to contact the undersigned attorney at (650) 833-2055 if a telephone conversation would be useful to expedite the prosecution of this case.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees to Deposit Account **No. 07-1896** referencing Docket No. 358261-991100 (formerly 1772-000002).

Respectfully submitted,

**DLA PIPER US LLP**

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